

Attorney Docket No. LWEP:121US
U.S. Patent Application No. 10/735,394
Reply to Office Action of March 6, 2006
Date: May 4, 2006

Amendments to the Drawings

The attached sheet of drawings includes changes to Sheets 1 and 2. These sheets, which include Figs. 1 and 2, respectively, replace the original Sheets 1 and 2 that included original Figs. 1 and 2. In Figures 1 and 2, reference number 9a has been added to indicate the changing surface of module changing apparatus 9.

Attachment: Replacement Sheets

Remarks

Amendment to Specification

Applicants have amended paragraph 0010 of the specification to provide a specific reference number 9a for the changing surface of module changing apparatus 9. Changing surface 9a can be seen in original Figures 1 and 2 of the specification and is discussed in paragraph 0010 of the specification as originally filed. For these reasons, Applicants respectfully submit that this amendment of paragraph 0010 does not add new matter. Applicants respectfully request entry of the amendment to paragraph 0010.

Applicants have amended paragraph 0013 of the specification to provide a written description of the attachment of changing surface 9a of module changing surface 9 to U-shaped microscope housing 1 at horizontal changing surface 3. This amendment of paragraph 0013 describes the attachment of module 4 to inverted microscope 1 as shown in original Figure 2. For this reason, Applicants respectfully submit that this amendment to paragraph 0013 adds no new matter. Applicants respectfully request entry of the amendment of paragraph 0013.

Amendment to the Drawings

Applicants have amended Figures 1 and 2 of the instant application. For both of Figures 1 and 2, Applicants have added reference number 9a to indicate the changing surface of changing apparatus 9 of module 4. Applicants respectfully note that the changing surface 9a was depicted in Figures 1 and 2 as originally filed. Consequently, Applicants respectfully submit that the amendments to Figures 1 and 2 add no new matter to the specification. Applicants respectfully request acceptance of the amended drawings and their entry into the record.

The § 102 (e) Rejections of Claims 1-5 and 8-18

The Examiner rejected Claims 1-5 and 8-18 under 35 U.S.C. § 102 (e) as anticipated by U.S. Patent Application Publication No. 2002/0131165 to Takahama ("Takahama" or "the

Takahama application”). Applicants have amended Claims 1-2 and 12-18. Applicants respectfully traverse the rejections of these claims as amended and request reconsideration.

“A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference.” *Vandergaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). MPEP § 2131. (Emphasis added.) In addition, “Every element of the claimed invention must be literally present arranged as in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). (Emphasis added.)

Applicants have amended Claim 1 to claim the horizontal changing surface 3 of the inverted microscope as an attachment surface 3 parallel to the base of the inverted microscope. This component of the claimed invention has been consistently depicted in Figure 2 and explained in paragraph 0013 of the specification as showing the apparatus as claimed in amended Claim 1. [See paragraph 0013 (page 4, lines 4-5.)]. Moreover, amended Claim 1 claims the invention in which both the binocular tube and photo tube both are arranged to extend above the attachment surface.

Takahama fails to disclose this claimed arrangement. Figures 7 and 8 of Takahama, referred to by the Examiner, fail to disclose a microscope in which a binocular tube and a photo tube mounted on the same module both extend above a housing attachment surface parallel to the base of the microscope. The Examiner has pointed to modules 54 and 201 of Figure 8 as comprising a horizontally protruding base. However, in Figure 8, modules 54 and 201 are depicted as separate modules and neither one is shown as having a protruding base attached to a housing attachment surface parallel to the base of that housing. Assuming *arguendo* both modules 54 and 201 are combined into one module, that one module is not attached to a microscope housing having an attachment surface parallel to the base of the microscope. Therefore, Applicants respectfully submit that Takahama fails to disclose each element of amended Claim 1 as arranged in that claim.

Claims 2-5 and 8-18 depend from Claim 1 and thus incorporate all the limitations of that claim. Because, as discussed above, the Takahama application fails to anticipate all the elements

of Claim 1, it also fails to anticipate Claims 2-5 and 8-18. Applicants respectfully request the removal of the rejections of Claims 2-5 and 8-18 and allowance of those claims.

In addition, Applicants respectfully specifically traverse the rejection of Claim 2 as anticipated by the Takahama application. Applicants respectfully note that Takahama fails to disclose the arrangement claimed in amended Claim 2, that is, a module with an attachment apparatus on the module that is configured to be attached to a housing attachment surface parallel to the base of that housing and that enables both the binocular tube and the photo tube to extend above the housing attachment surface. Therefore, for this additional reason, Applicants respectfully submit that the Takahama application fails to anticipate amended Claim 2 as that claim is arranged. Applicants respectfully request reconsideration and allowance of Claim 2 as amended.

Rejected Claims 8, 11, 12, 15, and 18 depend from Claim 2 and thus incorporate all the limitations of that claim. Because, as discussed above, the Takahama application fails to anticipate all the elements of Claim 2, it also fails to anticipate Claims 8, 11, 12, 15, and 18. Applicants respectfully request the removal of the rejections of Claims 8, 11, 12, 15, and 18 and allowance of those claims.

The § 103 (a) Rejections of Claims 6, 7, and 19-48

The Examiner rejected Claims 6, 7, and 19-48 under 35 U.S.C. § 103 (a) as obvious over the Takahama application. Applicants respectfully traverse these rejections and request reconsideration.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 6, 7, and 19-48 all claim an inverted microscope having a U-shaped microscope housing with one limb having a housing attachment surface parallel to the base of the housing.

Moreover, these claims also include the arrangement in which the binocular tube and photo tube of a module extend above the housing attachment surface. This specific arrangement is not disclosed or suggested in Takahama. In fact, Takahama discloses the binocular tube and photo tubes as connected to the front side of the housing. In paragraph 0055 of Takahama, the relay lens group **53** is described as arranged on the front side of the main body 1.” (Emphasis added.) In paragraph 0076, Applicants respectfully point out that the photographic device shown in Figures 7 and 8 is described by Takahama as connected to front ports of the inverted microscope as seen in Figures 2 and 3. In contrast, in the inventions claimed in the rejected claims the module is required to be on top of the housing as the claimed housing attachment surface is parallel to the base of the housing. The front side of the housings in both the claimed invention and in Takahama is not parallel to the base of the housing. Also, Applicants respectfully point out that multiple front ports or attachment points are taught in the Takahama application, while only a single top (parallel to base) housing attachment surface is claimed in Claims 6, 7, and 19-48. Therefore, the Takahama application fails to establish a *prima facie* case of obviousness against Claims 6, 7, and 19-48 as it fails to disclose all the elements of those claims. Additionally, Takahama makes no suggestion or teaching to place both the photo tube and the binocular tube on the top surface of the housing. Applicants respectfully request reconsideration and allowance of claims 6, 7, and 19-48.

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Conclusion

Applicants respectfully submits that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,



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APPENDIX